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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/574,766	04/06/2006	Martin Albrecht	CO/25-22960/A/PCT	2527
324	7590	11/24/2008	EXAMINER	
JoAnn Villamizar			LEE, DORIS L	
Ciba Corporation/Patent Department			ART UNIT	PAPER NUMBER
540 White Plains Road				1796
P.O. Box 2005				
Tarrytown, NY 10591				
MAIL DATE		DELIVERY MODE		
11/24/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/574,766	ALBRECHT ET AL.	
	Examiner	Art Unit	
	Doris L. Lee	1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 01 August 2008.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-18 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ . | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

1. The new grounds of rejection set forth below are necessitated by applicant's amendment filed on August 1, 2008. Thus, the following action is properly made final.
2. All outstanding objections and rejections, except for those maintained below, are withdrawn in light of applicant's amendment filed on August 1, 2008.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. **Claims 15 and 16** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 15 and 16, the process of claims 15 and 16 removes from the composition the solvent, however, the composition according to claim 1, from which claims 15 and 16 depend from, cannot be made from the process of recited in claim 15 because it necessarily contains a solvent, i.e. the base. Therefore the claims are indefinite, appropriate correction is required.

Claim Rejections - 35 USC § 102

6. **Claims 1-3, 10-12, 14 and 17-18** are rejected under 35 U.S.C. 102(b) as being anticipated by **Weinberger et al (US 6,008,291)**.

Regarding claims 1 and 3, Weinberger teaches a coating composition (Abstract) comprising

- an organic film forming binder such as polyester (col. 2, lines 40-55) and
- an inorganic additive with a base (col. 4, lines 44-50) of small particle size (col. 4, line 53) in an aqueous or alcoholic solvent (col 7, lines 13-26) prepared by the hydrolysis of a compound of formula Si(OR)₄ (col. 6, line 29-33).

Regarding claim 2, Weinberger teaches that the coating is transparent (col. 7, line 28).

Regarding claim 5, Weinberger teaches that the base is ammonia (col. 8, Examples)

Regarding claim 6, Weinberger teaches that the particle size is from 5 to 130 nm (col. 4, line 53).

Regarding claim 7, Weinberger fails to explicitly state that the hydrolysis takes place at a particular temperature; however, when chemical reactions occur and are not explicitly stated, it is taken to mean that the reactions occur at STP, standard temperature and pressure which falls within the claimed range.

Regarding claim 8, Weinberger teaches that component b is Si(OR)₄ which means that n=0 (col. 6, line 29-33).

Regarding claim 9, Weinberger teaches that component b is Si(OR)₄ which means that n=0 (col. 6, line 29-33) and R₂ is ethyl (col. 6, line 32). Weinberger teaches that this material is hydrolyzed (col. 6, line 37). Regarding the hydrolysis by ammonia, as this is a product-by-process claim; patentability of said claim is based on the recited

product and does not depend on its method of production. Since the product in the instant claim is the same as product disclosed by the prior art, the claim is unpatentable even if the prior art product was made by a different process. *In re Marosi*, 710 F2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983). See MPEP 2113.

Regarding claims 10 and 11, Weinberger teaches that the coating material can be used to coat wood, metal, plastic and concrete (col. 7, lines 60-63) and therefore is considered to be a paint. Weinberger also teaches that the coating material is an aqueous material (col. 7, line 17).

Regarding claim 12, Weinberger teaches that the resin is a polyester resin (Abstract).

Regarding claim 14, Weinberger teaches that the solid content of component (b) is present in an amount from 0.01 to 20% by weight of the overall solids content of the coating composition (col. 8, Example 1).

Regarding claim 17 and 18, Weinberger teaches that the resin is used as coating material and applied to wood, metal, plastic and concrete and is more scratch resistant (col. 7, line 55-65). As the coating is rendered harder, more scratch resistant and more chemically resistant, as a coating material, it is necessary that the solvent be removed via drying to form to hard coating composition.

Claim Rejections - 35 USC § 103

7. **Claims 4 and 13** are rejected under 35 U.S.C. 102(b) as being anticipated by **Weinberger et al (US 6,008,291)** in view of **Das et al (US 4,522,958)**.

The discussion regarding Weinberger in paragraph 6 above is incorporated here by reference.

Regarding claim 4, Weinberger teaches that an alcohol can be used as an auxiliary solvent (col. 7, line 20) or other organic solvents such as monoalkyl ethers of ethylene glycol, diethylene glycol (col. 7, lines 21), but fails to teach that the solvent is methanol, ethanol, n-propanol, isopropanol, n-butanol, isobutanol or tert-butanol.

Das teaches a coating material (Abstract) with a film forming polymer (Abstract) which has particles (Abstract) which are made from silicas (col. 8, lines 6-33). Das also teaches a solvent system in which alcohols such as methanol, ethanol, propanol, isopropanol, butanol, sec-butanol (col. 6, lines 15-25) as well as ethylene glycol monoethyl ether, or diethylene glycol monobutyl ether (col. 6, line 20-25).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to use the alcohols recited in Das as the alcohol of Weinberger. In view of Das's recognition that simple alcohols such as methanol and monoalkyl ethers of ethylene glycol are equivalent and interchangeable, it would have been obvious to one of ordinary skill in the art to substitute one with the other and thereby arrive at the present invention. Case law holds that the mere substitution of an equivalent (something equal in value or meaning, as taught by analogous prior art) is not an act of invention; where equivalency is known to the prior art, the substitution of one equivalent for another is not patentable. See *In re Ruff* 118 USPQ 343 (CCPA 1958).

Regarding claim 13, Weinberger teaches that this composition can be used for coating materials such as wood, metal, plastic and concrete (col. 7, lines 60-64),

however fails to teach that the coating composition can further contain additives as recited in the instant claim.

Das teaches a coating material (Abstract) with a film forming polymer (Abstract) which has particles (Abstract) which are made from silicas (col. 8, lines 6-33). Das also teaches a pigment can be added (col. 6, line 32-55).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to use the pigment of Das in the composition of Weinberger. One would have been motivated to do so in order to receive the expected benefit of having a beautifully colored coating. They are combinable because they are both concerned with the same field of endeavor, namely coating materials with a film forming polymer and particles make from silicas. Absent objective evidence to the contrary and based upon the teaching of the prior art, there would have been a reasonable expectation of success.

Response to Arguments

8. Applicant's arguments with respect to all the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Doris L. Lee whose telephone number is (571)270-3872. The examiner can normally be reached on Monday - Thursday 7:30 am to 5 pm and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571)272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Doris L Lee/
Examiner, Art Unit 1796

/Vasu Jagannathan/
Supervisory Patent Examiner, Art Unit 1796